

This Opinion is Not a
Precedent of the TTAB

Mailed:
June 24, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

—
NIKE, Inc.

v.

Capital E Finance Co., LLC

—
Opposition No. 91221511
—

Helen Hill Minsker and Audra C. Eidem Heinze of Banner & Witcoff, Ltd.
for NIKE, Inc.

Capital E Finance Co., LLC, *pro se.*

—
Before Wolfson, Lykos and Masiello, Administrative Trademark Judges.
Opinion by Lykos, Administrative Trademark Judge:

On July 8, 2014, Capital E Finance Co., LLC (“Applicant”) filed an application under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), to register on the Principal Register the mark **Just Did It** in standard characters for the following goods in International Class 25:¹

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¹ Application Serial No. 86330661, alleging a *bona fide* intent to use the mark in commerce.

Apparel for dancers, namely, tee shirts, sweatshirts, pants, leggings, shorts and jackets; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic shirts; Button down shirts; Button-front aloha shirts; Clothing for athletic use, namely, padded shirts; Collared shirts; Golf shirts; Graphic T-shirts; Hooded sweat shirts; Knit shirts; Long-sleeved shirts; Maternity clothing, namely, shirts; Night shirts; Open-necked shirts; Polo shirts; Rugby shirts; Shirts and short-sleeved shirts; Shirts for infants, babies, toddlers and children; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sleeves worn separate and apart from blouses, shirts and other tops; Sport shirts; Sports shirts; Sports shirts with short sleeves; Sun protective clothing, namely, shirts; Sweat shirts; T-shirts; Tee shirts; Triathlon clothing, namely, triathlon tights, triathlon shorts, triathlon singlets, triathlon shirts, triathlon suits; Turtle neck shirts; Wearable garments and clothing, namely, shirts; Yoga shirts.

NIKE, Inc. (“Opposer”) opposed the registration of Applicant’s mark on the grounds of likelihood of dilution by blurring under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on Opposer’s previously used and registered JUST DO IT marks. Opposer pleaded ownership of and submitted with its notice of opposition copies of the following registrations obtained from the U.S. Patent and Trademark Office’s (“USPTO”) Trademark Status and Document Retrieval (“TSDR”) database, thereby making them of record pursuant to Trademark Rule 2.122(d)(1):

Registration No. 1875307 for the mark **JUST DO IT.** in typed format² on the Principal Register for “clothing, namely t-shirts, sweatshirts and caps” in International Class 25; registered January 24, 1995; renewed.

² Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. Trademark Manual of Examining Procedure (“TMEP”) § 807.03(i) (April 2016).

Registration No. 4350316 for the mark **JUST DO IT** in standard characters on the Principal Register for “eyeglass frames; sunglasses” in International Class 9; registered on June 11, 2013.

Registration No. 4704671 for the mark **JUST DO IT** in standard characters on the Principal Register for “[c]ell phone cases; parts and accessories for cell phones, namely, cell phone covers; specialty carrying cases for cell phones; cases for hand-held computing devices; protective covers for hand-held computing devices; eyewear; sunglasses” in International Class 9; registered on March 17, 2015.

Opposer also pleaded ownership of pending Application Serial No. 86444421 which subsequently matured into the registration listed below.

Registration No. 4764071 for the mark **JUST DO IT** in standard characters on the Principal Register for “All purpose sport bags; Backpacks” in International Class 18 and “Footwear; Headbands; Headwear; Pants; Shorts; Sports bras; Tank tops; Tights; Warm up suits” in International Class 25; registered June 30, 2015.

In its answer to the notice of opposition, Applicant admitted Opposer’s ownership of its pleaded registrations and application. In addition, Applicant admitted the allegations that “Opposer’s use ... of its JUST DO IT Mark is long prior to the filing date of the opposed Application” (¶ 14); that Opposer’s JUST DO IT mark “which has been in use in commerce for more than twenty-five years” is “famous within the meaning of Section 43(c) of the [Trademark] Act, 15 U.S.C. § 1125(c)” (¶ 20); and that “Opposer’s JUST DO IT Mark became famous prior to the filing date of the Application for Applicants’ Mark and prior to any date of first use or first use in commerce of Applicants’ Mark” (¶ 21).³

³ We construe Applicant’s responses in its answer that “Applicant concurs/agrees” as admissions. *See* Fed. R. Civ. P. 8(e) (“Pleadings must be construed so as to do justice.”). *See also* Trademark Rule 2.106(b)(1) (“An answer shall state in short and plain terms the applicant’s defenses to each claim asserted and shall admit or deny the averments upon which the opposer relies.”).

(TTABVUE Entry # 5). Otherwise Applicant denied the salient allegations therein.

I. *The Record; Accelerated Case Resolution*

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b), Applicant's application file.

The parties stipulated to resolve this proceeding under the stipulated record model of the Board's Accelerated Case Resolution ("ACR") procedure, and are commended for pursuing this expeditious, cost-efficient alternative to trial. *See* "Stipulation of the Parties for Use of Accelerated Case Resolution (ACR) Procedure" (TTABVUE Entry #10) (hereinafter referred to as "ACR agreement"). Under the ACR model selected by the parties, in lieu of separate assigned testimony and briefing periods, each party submitted briefs with evidentiary submissions attached thereto, effectively merging the trial and briefing periods into a single phase. Witness testimony was presented in declaration form. *Id.* In addition, the evidentiary record has been stipulated to in substantial part. *See* Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 702.04(d) (2015) ("ACR using Stipulated Record and Trial Briefs").

Pursuant to their ACR Agreement, the parties entered into various procedural stipulations approved by the Board, including the following:

The parties waived all disclosures;

Neither party shall conduct discovery or rely on expert testimony;

The parties shall forego trial and an oral hearing;

The parties shall submit briefs, accompanied by evidence which may be submitted in the form of declarations or affidavits and exhibits thereto, similar to the format for summary judgment; evidence that may be submitted under notice of reliance under normal trial procedures may also be submitted as attachments to the parties' briefs;

The page limit for the parties' briefs shall be the page limit permitted for trial briefs pursuant to Trademark Rule 2.128(b);

The parties may raise substantive objections to evidence pursuant to the Federal Rules of Evidence; and

The parties agreed that the Board may resolve genuine disputes of material fact and issue a final ruling based on the parties' ACR submissions.

In addition, as per their ACR stipulation, the parties stipulated to numerous facts as not in dispute (TTABVUE Entry # 12), including the following:

“NIKE is a leading sport and fitness company and leading provider of a broad range of clothing, footwear, sporting goods, athletic equipment and related products and services.” (¶ 1)

Opposer has standing to bring this proceeding based on its prior pleaded registrations and application which subsequently matured into registration. (¶ 2)

“NIKE began using the trademark JUST DO IT in connection with the goods cited in its pleaded registrations prior to the filing date of [Applicant's] application on July 8, 2014.” (¶ 6)

“NIKE has used the trademark JUST DO IT in commerce continuously since January 26, 1989.” (¶ 7)

“NIKE's trademark JUST DO IT is famous.” (¶ 8)

“NIKE's trademark JUST DO IT became famous before [Applicant] filed its application for JUST DID IT on July 8, 2014.” (¶ 9)

Opposer has successfully opposed or petitioned to cancel numerous trademark applications and registrations of the marks including the phrase “JUST ... IT.” (¶ 15)

“Applicant is a company primarily engaged in the business of financing or arranging financing for energy and environmental related projects.” (¶ 16)

“[Applicant] does not claim rights to JUST DID IT as a trademark in connection with any of the goods set forth in its application prior to the filing date of its application on July 8, 2014.” (¶ 19)

“[Applicant] did not use JUST DID IT as a trademark in connection with any of the goods set forth in its application prior to the filing date of its application on July 8, 2014.” (¶ 20)

“Since filing its Application Serial No. 86/330,661, [Applicant] has not made use, or use in commerce, of its mark JUST DID IT as a trademark in connection with the goods set forth in its application.” (¶ 21)

“NIKE has never given [Applicant] any consent or permission or otherwise authorized [Applicant] to use or register the JUST DO IT mark in connection with any goods or services, nor has Applicant requested the same.” (¶ 22)

“There is no connection or affiliation between NIKE and [Applicant] or [Applicant’s] goods or services.” (¶ 23)

It was proper to stipulate to all of the aforementioned facts as undisputed. We are compelled, however, to comment on some of the other “stipulated facts” entered into by the parties. In particular, the parties “stipulated” as to certain portions of a prior Board decision involving Opposer as plaintiff and an unrelated defendant, *Nike Inc. v. Maher*, 100 USPQ2d 1018 (TTAB 2011) where the Board sustained both Opposer’s Section 2(d) and dilution by blurring claims. For example, the parties “stipulated” that in the *Nike v. Maher* case, the Board “held that NIKE’s trademark is famous for both likelihood of confusion and di-

lution purposes.” ACR Stipulation ¶10. Assuming that the parties’ characterization of this earlier case is correct, this stipulation does not function to establish, for purposes of this proceeding, the findings made in that proceeding.

Opposer timely submitted an ACR brief accompanied by the following declarations with exhibits attached thereto: (1) Jaime Lemons, Opposer’s Global Counsel, Trademark and Copyright; (2) Melanie Sedler, a trademark paralegal and employee of Opposer since 1979; and (3) Nathan Kappes, a litigation paralegal at Banner & Witcoff, Ltd. In addition, Opposer properly made of record under notice of reliance its pleaded application which matured into Registration No. 4764071⁴ as well as numerous articles and advertisements featuring or discussing Opposer’s JUST DO IT trademark.

Applicant also filed an ACR brief,⁵ and Opposer in turn filed a reply.

As noted above, the parties have stipulated to many of the critical facts, and Applicant submitted no admissible evidence. Nonetheless, as plaintiff in this

⁴ Opposer’s submission under notice of reliance of its other pleaded registrations was superfluous since they were properly made of record with its notice of opposition.

⁵ We sustain Opposer’s objection to the evidence submitted under notice of reliance with Applicant’s ACR brief consisting of website links purportedly to listings showing third-party usage of the slogan “Just Do It.” It is well established that “Internet search summaries, which essentially are links to the website pages, are not admissible under notice of reliance.” TBMP § 704.08(b). *Cf. In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1050 (TTAB 2006) (in the *ex parte* context, web site links “do little to show the context within which a term is used on the web page that could be accessed by the link.”). By logical extension, hyperlinks utterly devoid of content offer no probative value and clearly do not meet the requirements for admissibility under notice of reliance as set forth in *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031 (TTAB 2010). This is because the content associated with each link can change at any given moment.

proceeding, Opposer bears the burden of proving its standing and claims by a preponderance of the evidence.

II. *Standing*

The parties stipulated that Opposer has standing to bring the claims asserted in this proceeding.⁶

III. *Dilution by Blurring*

Turning now to the substantive matters before us, we commence with Opposer's claim of dilution by blurring. The Trademark Act provides a cause of action for the dilution of famous marks. *See* Sections 13 and 43(c) of the Trademark Act, 15 U.S.C. §§ 1063 and 1125(c). Section 43(c) provides as follows:

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

The Trademark Act defines dilution by blurring as follows:

“[D]ilution by blurring” is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.

Section 43(c)(2)(B) of the Trademark Act, 15 U.S.C. § 1125(c)(2)(B). “Dilution diminishes the ‘selling power that a distinctive mark or name with favorable

⁶ And even absent a stipulation, Opposer, by submitting printouts obtained from the USPTO electronic database records showing the current status and title of its pleaded registrations, has established its standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

associations has engendered for a product in the mind of the consuming public.” *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1182 (TTAB 2001) (internal citation omitted) (“*Toro*”). In oppositions to intent-to-use applications filed under Trademark Act Section 1(b), the Board applies the following three-prong test for dilution by blurring:

1. Whether Opposer’s mark is famous⁷ and distinctive;⁸
2. Whether Opposer’s mark became famous prior to applicant’s date of constructive use or filing date; and
3. Whether Applicant’s mark is likely to cause dilution by blurring the distinctiveness of Opposer mark.

⁷ Under § 1125(c)(2)(A), a mark is “famous” for dilution purposes —

... if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

⁸ “[A] mark must be not only famous, but also so distinctive that the public would associate the term with the owner of the famous mark even when it encounters the term apart from the owner’s goods or services, i.e., devoid of its trademark context.” *Toro*, 61 USPQ2d at 1177 (citing H.R. REP. No. 104-374, at 3 (1995) (“the mark signifies something unique, singular, or particular”). *See also Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1723-24 (Fed. Cir. 2012) (“*Coach Services*”).

See e.g., National Pork Board v. Supreme Lobster and Seafood Co., 96 USPQ2d 1479, 1494-95 (TTAB 2010).⁹

Applicant, in its answer, admitted that Opposer's JUST DO IT mark is famous for dilution purposes and that it became famous prior to the filing date of Applicant's application.¹⁰ Answer ¶¶ 20 and 21. ¹¹ We further find that in addition to being famous for dilution purposes, Opposer's mark is "distinctive" within the meaning of Section 43(c) of the Act. As noted above, each of Opposer's pleaded registrations for the mark JUST DO IT are subsisting on the Principal Register, evidence that the mark is inherently distinctive. Thus, the crux of Opposer's dilution by blurring claim hinges on our analysis of the third prong - whether Applicant's JUST DID IT mark is likely to cause dilution by blurring the distinctiveness of Opposer's JUST DO IT mark.

Dilution by blurring is an "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark," 15 U.S.C. § 1125(c)(2)(B), and may be found "regardless of

⁹ Our primary reviewing court, the Court of Appeals for the Federal Circuit, has set forth a slightly different test for oppositions against use-based applications filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(b). *See Coach Services*, 101 USPQ2d at 1723-24.

¹⁰ Regardless, there is ample evidence in the record showing that Opposer's JUST DO IT mark achieved fame for dilution purposes prior to July 8, 2014, the filing date of the involved application.

¹¹ Because the ACR stipulation stipulates merely that Opposer's JUST DO IT mark is "famous" but does not specify that it is famous for dilution or Section 2(d) purposes, we rely instead on Applicant's admissions in its answers. *See* ACR Stipulation ¶¶ 8 and 9.

the presence or absence of actual or likely confusion, of competition, or of actual economic injury,” 15 U.S.C. § 1125(c)(1). Dilution by blurring occurs when a substantial percentage of consumers, upon seeing the junior party’s use of a mark on its goods or services, are immediately reminded of the famous mark and associate the junior party’s use with the owner of the famous mark, even if they do not believe, for example, that the goods or services come from the famous mark’s owner, or that the famous mark’s owner approves the goods or services. In addition, we must determine not only whether there is an ‘association’ arising from the similarity of the marks, but whether such association is likely to ‘impair’ the distinctiveness of the famous mark. *Nike Inc. v. Maher*, 100 USPQ2d at 1023. In determining whether a mark or trade name is likely to cause dilution by blurring, the Board may consider the following non-exhaustive list of six factors:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.

15 U.S.C. § 1125(c)(2)(B)(i)-(vi). We now consider each of these factors in turn.

(i) The degree of similarity between the mark or trade name and the famous mark

Applicant argues that while Opposer's JUST DO IT mark projects a "call to arms, encouraging consumers to follow through with their goals" and to "compete, work, hustle," Applicant's mark JUST DID IT "embodies a call to celebrate and reflect on one's successes such as graduation, birth, marriage, etc... and a call for others to recognize that success." Applicant's ACR Brief, 23 TTABVUE 11.

Applicant's argument is unpersuasive. The marks in question are almost identical. Applicant's mark JUST DID IT merely is the past tense version of Opposer's JUST DO IT mark. As such, the marks are "sufficiently similar to trigger consumers to conjure up a famous mark when confronted with the second mark." *National Pork Board*, 96 USPQ2d at 1497. This factor therefore favors finding a likelihood of dilution by blurring.

(ii) The degree of inherent or acquired distinctiveness of the famous mark

"This factor requires us to analyze how distinctive or 'unique' the mark is to the public. The inquiry is made even when it is undisputed that opposer's mark is registered on the Principal Register." *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2025 (TTAB 2014) (quoting *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718, 1735 (TTAB 2003)). "The more inherently distinctive and memorable the mark, the more it is likely to be blurred by the use of other identical or similar marks. The more descriptive the mark, the less likely it is

to be blurred by uses of identical or similar marks.” Testimony of Anne Gundelfinger, President, International Trademark Association, before House Subcommittee on Courts, the Internet and Intellectual Property, Committee on the Judiciary, February 17, 2005 (109th Cong., 1st Sess.), 2005 WL 408425.

As noted above, Opposer’s mark JUST DO IT is inherently distinctive as evidenced by its registrations on the Principal Register. Moreover, there is no evidence that JUST DO IT has any descriptive meaning as applied to Opposer’s goods, nor is there any evidence showing that its distinctiveness is weakened by suggestiveness in the relevant field. In addition, the record shows that Opposer’s JUST DO IT mark has acquired a high degree of acquired distinctiveness among consumers. At its initial launch in 1988, Opposer distinguished its JUST DO IT brand name from other competitors in the athletic apparel industry by introducing a series of commercials featuring ordinary people. Sedler Decl. ¶¶ 8-14, Exs. D-1 (internal document explaining “Just Do It” campaign), D-2 (television commercial featuring eighty-year old man running across San Francisco Bay Bridge), D-3 (screenshots of television commercial featuring former smoker and New York marathon winner Priscilla Welch); 19 TTABVUE 4-7, 14-31. To promote its new slogan, Opposer spent over \$5.6 million in television and print advertisements in a three-month period. *Id.* at ¶¶ 8-14, 19 TTABVUE 4-7. Opposer’s promotional efforts to garner consumer recognition of its mark were initiated throughout the entire company, as evidenced by the display of the JUST DO IT slogan in the lobby of NIKE buildings and retail

stores, automated telephone greetings and messages consisting of “NIKE – JUST DO IT”, and the inclusion of the slogan on shipping cartons and outgoing correspondence. *Id.* at ¶ 9-10, 19 TTABVUE 4-5. The high level of expenditures continued after the launch - since 2008, Opposer estimates that it has spent approximately \$200 million on advertisements and promotions of its JUST DO IT mark. *Id.* at ¶ 26, 19 TTABVUE 12. Many of Opposer’s JUST DO IT television commercials are so popular with consumers that they are viewed repeatedly via YouTube. *Id.* at ¶ 20, 19 TTABVUE 9 (*e.g.*, Charles Barkley “Role Model”; “If You Let Me Play”). For example, in 2008, Opposer aired a commercial during the 2008 Olympics featuring Carl Lewis to commemorate the 20th anniversary of the JUST DO IT campaign which subsequently received over 1 million views on YouTube. *Id.* In addition to print and television advertising, Opposer reaches consumers with its JUST DO IT slogan via social media platforms such as Facebook, Instagram and Twitter. *Id.* at ¶ 25, 19 TTABVUE 11; Kappes Decl. ¶¶ 4-6, Exs. E-3 to E5 (Facebook, Instagram and Twitter screenshots), 20 TTABVUE 3-4, 66-118. Opposer’s substantial sales of its JUST DO IT branded apparel and ancillary goods reflect these efforts, with estimated sales totaling over 27.5 million units “in every state in the United States” between 1989-2009. Lemons Decl. ¶ 11, Ex. C-2 (product sales spreadsheet), 18 TTABVUE 6, 13-251. “Since 2009, Opposer has sold over 30 million additional units of products bearing the JUST DO IT trademark in every state of the United States.” *Id.* at ¶ 12, 18 TTABVUE 6.

Applicant contends that Opposer's mark JUST DO IT is not distinctive "because it has been and will continue to be used in regular conversation, unrelated to NIKE or sports, for decades." Applicant's ACR Brief, 14 TTABVUE 11. Applicant's argument reflects a misunderstanding of the concept of distinctiveness. As noted above, the record more than amply supports this finding. This factor also favors a finding of likelihood of dilution.

(iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark

Opposer's JUST DO IT slogan is one of its most valuable trademarks (Lemons Decl. ¶ 6, 18 TTABVUE 4), and has been the subject of unauthorized copying (*Id.* at ¶ 20, 18 TTABVUE 9). Consequently, Opposer has a long history of vigorously enforcing its rights against third parties. *Id.* at ¶ 6, 18 TTABVUE 4. Opposer has sent numerous cease and desist letters to unauthorized users of its mark, and has also pursued legal action in numerous court proceedings. *Id.* at ¶¶ 21 and 23, Exs. C-5 (cease and desist letters), 18 TTABVUE 9-10, 265-305. In addition, the parties stipulated that Opposer has successfully challenged before this tribunal thirty-four applications and registrations incorporating the phrase "JUST ... IT." ACR Stipulation ¶ 15. Opposer typically declines requests from third parties seeking permission to use JUST DO IT or JUST ___ IT (Lemons Decl. at ¶ 21, 18 TTABVUE 9). Accordingly, we find that Opposer has made "substantially exclusive" use of the JUST DO IT trademark, and therefore, this dilution factor weighs in favor of a likelihood of dilution.

(iv) The degree of recognition of the famous mark

The record shows that Opposer's JUST DO IT mark is universally recognized throughout the United States. Opposer's customers include "men, women and children of essentially all age groups and backgrounds, including those who do not consider themselves athletes." Sedler Decl. ¶ 7, 19 TTABVUE 4. One unsolicited survey referred to the slogan "as one of the most famous and easily recognized advertising slogans in advertising history." Lemons Decl. ¶ 17, Ex. C-3 (Center for Applied Research, "*Mini-case Study: Nike's 'Just Do It' Advertising Campaign*"), 18 TTABVUE 8, 254-258. The mark has been the subject of an extensive level of unsolicited media coverage and accolades. *See* Opposer's Notice of Reliance (15, 16 TTABVUE). By way of illustration, we highlight the following:

"Nike's "Just Do It" is arguably the best tagline of the 20th century. It cut across age and class barriers, linked Nike with success – and made consumers believe they could be successful too just by wearing its products." *History of Advertising: No. 118: Nike's 'Just Do It' tagline*, Campaign Live. Jan. 22, 2015 (Kappes Decl. ¶ 23, Ex. E-22, 20 TTABVUE 8, 223-233).

"*Just do it.*" Those three little words have inspired a whole host of people the world over to do just that. They compete. They work. They hustle. They just *do* it. That phrase, which has become synonymous with success, with strength, with perseverance *is* Nike's brand." Wright, Meghan, *Just Do It: Nike's Marketing Strategy and How They're Getting it Done*, Advat, May 28, 2015 (Kappes Decl. ¶ 25, Ex. E-24, 20 TTABVUE 9, 244-253).

"Nike dominates the U.S. athletic shoe industry, testimony to a marketing machine so successful that the company's "Just Do It" slogan and "swoosh" logo are part of popular culture." *Nike Does What Customers Want*, Plain Dealer (Cleveland, OH) Jan. 6, 1996 (Opposer's Notice of Reliance at 15 TTABVUE 124).

Even Applicant in its brief acknowledges as much, conceding that the mark JUST DO IT is “so famous and widespread as to be unassailable in its position and ties to the NIKE brand of clothing.” Applicant’s ACR Brief, 14 TTABVue 9. This unusually high degree of consumer recognition strongly favors a likelihood of dilution.

(v) Whether the user of the mark or trade name intended to create an association with the famous mark

Opposer has presented no evidence demonstrating that Applicant intended to create an association with Opposer’s famous JUST DO IT mark. As such, this dilution factor is neutral.

(vi) Any actual association between the mark or trade name and the famous mark

Insofar as the parties have stipulated that Applicant has not made any use of its applied-for mark in commerce, we also deem this factor neutral. ACR Stipulation ¶¶ 20, 21.

(vii) Other factors

The aforementioned factors are non-exhaustive, meaning that the Board may consider other factors. *See Nike v. Maher*, 100 USPQ2d at 1030. Here, we note that Applicant’s and Opposer’s goods are in part identical. “[C]ourts have observed that ‘the closer the products are to one another [in the marketplace], the greater the likelihood of both confusion and dilution.’” *Toro*, 61 USPQ2d at 1184 (internal citations omitted). This factor also favors finding a likelihood of dilution.

Conclusion

Each factor, with the exception of the fifth and sixth factors discussed above which were deemed neutral, favors a finding of likelihood of dilution by blurring.

The statute also requires Opposer to prove impairment of the distinctiveness of Opposer's famous mark. *See Nike Inc. v. Maher*, 100 USPQ2d at 1023. *See also Louis Vuitton Malletier S.A. v. Haute Diggity Dog LLC*, 507 F.3d 252, 84 USPQ2d 1969 (4th Cir. 2007). We find impairment based on the fact that the application contemplates that Applicant's mark would be used in direct competition with Opposer.

In summary, we find that, based on the record before us, Opposer has demonstrated by a preponderance of the evidence that Applicant's mark JUST DID IT is likely to cause dilution by blurring of its JUST DO IT trademark.

IV. Section 2(d) Claim

We will now consider Opposer's Section 2(d) claim, focusing on Opposer's registered marks JUST DO IT. and JUST DO IT for the goods identified in Registration Nos. 1875307 and 4764071.

A. Priority

Priority is not at issue in view of Opposer's ownership of valid and subsisting registrations for the goods identified therein. *See King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

B. Likelihood of Confusion

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “Not all of the du Pont factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). For example, the Board can “focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citation omitted). These factors, and the other relevant *du Pont* factors are discussed below.

1. *Fame of the Prior Mark*

We begin with the fame of Opposer’s **JUST DO IT** mark. Fame of the prior mark, if it exists, plays a dominant role in a likelihood of confusion analysis. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). Fame for likelihood of confusion purposes and fame for dilution purposes are distinct concepts.¹² See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*

¹² Unlike dilution, fame for likelihood of confusion does not require the opposer to show fame among every segment of the U.S. population. Rather, fame for likelihood of confusion purposes arises as long as a “significant portion of the relevant consuming public

Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“*Palm Bay Imports*”). Given Applicant’s admission in its answer that Opposer’s mark **JUST DO IT** is famous under the more stringent standard required for dilution, we deem such admissions as a concession that Opposer’s mark is also famous for likelihood of confusion purposes for the goods identified in the involved registrations. Moreover, the evidence presented in support of Opposer’s dilution claim, discussed *supra*, equally supports Opposer’s claim that its mark is famous for Section 2(d) purposes. This factor strongly favors a likelihood of confusion.

2. *The Goods and Trade Channels*

The next step in our analysis is a comparison of the goods identified in Applicant’s application vis-à-vis the goods identified in Opposer’s pleaded registrations. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). See also, *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

At the outset, we note that the involved application and Opposer’s pleaded Registration Nos. 1875307 and 4764071 involve goods that are either identical

... recognizes the mark as a source indicator.” *Palm Bay Imports*, 73 USPQ2d at 1694. See e.g., *Weider Publ’ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1355 n.20 (TTAB 2014) (Board found opposer’s pleaded SHAPE marks famous for purposes of the likelihood of confusion analysis for magazines in print and online form as well as the provision of related online Internet content but not for clothing.).

or legally identical, at least in part. This is because Opposer's broadly worded "clothing, namely t-shirts, sweatshirts and caps" identified in its pleaded Registration No. 1875307 and "footwear; headbands; headwear; pants; shorts; sports bras; tank tops; tights; warm up suits" identified in Registration No. 4764071 necessarily encompass many of Applicant's more narrowly identified clothing items such as "athletic apparel, namely pants, ... footwear, hats and caps, clothing for athletic use, namely, graphic t-shirts; hooded sweat shirts." Given that the goods are either identical or legally identical, at least in part, this *du Pont* factor weighs in favor of finding a likelihood of confusion.

Because the goods are legally identical in part, and neither Opposer's registration nor the involved application contain any limitations on the channels of trade and classes of purchasers, we must presume that the channels of trade and classes of purchasers are the same. *See Stone Lion*, 110 USPQ2d at 1161; *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presump-

tion in determining likelihood of confusion). As such, the *du Pont* factor regarding the similarity or dissimilarity of established, likely to continue trade channels also favors a finding of likelihood of confusion.

3. *The Marks*

We now turn to the *du Pont* likelihood of confusion factor regarding the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports*, 73 USPQ2d at 1692.

Applicant contends that the marks in question have “completely different connotations,” with Opposer’s JUST DO IT mark meaning a “[c]all to action” versus Applicant’s JUST DID IT mark signifying “[a] [c]all to relax and celebrate.” Applicant’s Brief, 15 TTABVUE 12. Applicant’s arguments are unpersuasive. Applicant’s mark is merely the past tense version of Opposer’s slogan. Thus, the marks are nearly identical not only in how they look and sound but also in connotation and commercial impression.¹³ And because Applicant’s mark is in standard characters and Opposer’s registered marks are in typed format, they could conceivably be used in the same stylized format. *See* Trademark Rule 2.52(a). *See also* Trademark Manual of Examining Procedure (“TMEP”) § 807.03(a) (April 2016) (“If the applicant files an application on paper that includes a standard character claim, the applicant may depict the mark in any

¹³ The period in the mark JUST DO IT. in Opposer’s Registration No. 1875307 does little to change the mark’s commercial impression.

font or style; may use bold or italicized letters; and may use both uppercase and lowercase letters, all uppercase letters, or all lowercase letters, since no claim is made to any particular font style, size, or color.”) (emphasis in original). We therefore find that Opposer’s marks and Applicant’s mark are similar in appearance, sound, connotation and commercial impression. This first *du Pont* factor weighs in favor of finding a likelihood of confusion as well.

4. *Balancing the du Pont Factors*

In the present case, the *du Pont* factors discussed above favor a finding of likelihood of confusion. Accordingly, we find that Opposer has proved its Section 2(d) claim by a preponderance of the evidence.

Decision: The opposition is sustained on Opposer’s claim of dilution by blurring and Opposer’s Section 2(d) claim.